

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 4-10, 12-14, and 16 are currently pending in this application, Claims 1 and 7, 8, 9, and 16 having been amended, and Claims 3, 11 and 15 having been canceled without prejudice or disclaimer by the present amendment. Support for the amendment to Claims 1 and 7 is found, for example, in the specification at page 15, line 24. Support for the amendments to Claims 9 is found, for example, in Claim 15. Support for the amendment to Claims 8 and 16 is found, for example, in the specification at page 24, lines 18-19. Thus, no new matter is added.

In the outstanding Office Action, Claim 1, 4, 5, 7, 9, 12, 13, and 15 were rejected under 35 U.S.C. §103(a) as anticipated by Iwama et al. (JP 11-24507, hereinafter Iwama) in view of Kawaguchi et al. (JP 2002-251078a, hereinafter Kawaguchi); Claims 8 and 16 were rejected under 35 U.S.C. §103(a) as unpatentable over MOrikoshi et al. (JP 4-333457, hereinafter Morikoshi) in view of Kawaguchi; and Claims 2, 6, 10, and 14 were allowed.

Applicant acknowledges with appreciation the indication of allowable subject matter.

As an initial matter, it is noted that MPEP §706.02 II (pages 22 and 23 of MPEP rev. 3, August 2005) is relevant to rejections based on English Abstracts and/or the underlying foreign language document. This MPEP section makes it clear that if the Examiner is relying on both the English Abstract and the underlying Japanese documents (JP 11-24507 and JP 4-333457), a translation of these documents is to be obtained and supplied prior to implementing a final Action. As the present Action includes no translation of the underlying documents, the outstanding Office Action must be relying on the English Abstracts alone. However, MPEP §707.02 II makes it clear that such reliance is “inappropriate where both the abstract and the underlying document are prior art.” *See also Ex Parte Gavin* 62 USPQ2d

1680 where the Board of Patent Appeals and Interferences placed the burden of obtaining a translation on the Examiner.

Moreover, MPEP §706.02(II) states “The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. §103, when the abstract alone appears to support the rejection.” Thus, without a full translation of the underlying document, the merits of the outstanding rejection cannot be fully evaluated.

Accordingly, it is respectfully submitted that the present Action that must be relying only on the English Abstracts of the above-noted Japanese references and is inappropriate and should be withdrawn. Furthermore, to the extent that any subsequent Action relies on JP 11-24507 and JP 4-333457, a copy of the full translations should be supplied as required under MPEP §706.02 II.

With respect to the rejection of Claims 1 and 7, Applicant respectfully submits that the amendment to Claim 1 overcomes the outstanding ground of rejection. Amended Claims 1 and 7 recite, *inter alia*, “wherein the Young’s modulus of the belt is in a range of 3000 megapascals to 7000 megapascals.”

Neither Iwama nor Kawaguchi describe or suggest this element of amended Claims 1 and 7.

Accordingly, Applicant respectfully submits that amended Claims 1 and 7 (and Claims 3, 4, and 5) patentably distinguish over Iwama and Kawaguchi, taken alone or in proper combination.

Moreover, Applicant respectfully submits that Claim 4 further patentably distinguishes over Iwama and Kawaguchi. The outstanding Office Action relies on Official Notice for the teaching that it is known in the art to use a scale having magnetic and non-magnetic portions. To support this assertion, the outstanding Office Action cites Temple

(U.S. Patent No. 5,313,254). However, the outstanding Office Action provides no support for the assertion that any of the cited references disclose or suggest the claimed “wherein the scale...includes a reflecting part and a non-reflecting part repeatedly disposed along the length of the scale at a predetermined interval.” The outstanding Office Action merely states that “a magnetic scale is functionally equivalent to a reflective scale.” However, functional equivalence is not the standard for obviousness. As stated in MPEP § 2143, the standard for establishing obviousness is:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, **there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.** Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.**

As the outstanding Office Action has pointed to nothing in the references themselves or elsewhere in the record disclosing the claimed “reflecting part and a non-reflecting part repeatedly disposed along the length of the scale at a predetermined interval” or a motivation to switch from a magnetic system to a reflective system, Applicant respectfully submits that the outstanding Office Action has not satisfied the burden under §2143 for a *prima facie* case of obviousness.

Furthermore, if the outstanding Office Action is relying on Official Notice that it is known in the art to have a “reflecting part and a non-reflecting part repeatedly disposed along the length of the scale at a predetermined interval,” Applicant respectfully traverses this position. Applicant does not consider the features for which Official Notice were taken to be “of such notorious character that Official Notice can be taken.” As set forth in M.P.E.P. §2144.03, if an applicant traverses an assertion made by an Examiner while taking official notice, the Examiner should cite a reference in support of their assertion.

With respect to the rejection of Claim 15, the subject matter of which is now included

in Claim 9, Applicant respectfully traverses the rejection. Amended Claim 9 recites, *inter alia*, “a timing control unit that controls a start timing of an image forming operation based on a result of reading of the reading unit.”

The outstanding Office Action relies on Iwama and Kawaguchi in the rejection of Claim 15, the subject matter of which is now in Claim 9. However, the outstanding Office Action does not cite to any section in Iwama and Kawaguchi as disclosing the above-noted element. Moreover, the outstanding Office Action does not even address the above-noted element of amended Claim 9. Thus, the outstanding Office Action has not established a *prima facie* case of obviousness.

Iwama states in the solution section of the English Abstract that “a driving motor 9 for driving the transfer belt 2 is controlled based on the detection result of the detector 11.” However, driving a belt based on the detection result does not equate to the claimed “a timing control unit that controls a *start timing of an image forming operation* based on a result of reading of the reading unit” (emphasis added).

If the outstanding Office Action is taking the position that the above-noted element of amended Claim 9 is inherent in the cited references, this position is traversed. The Office Action provides no rationale for a finding of inherency. “The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.”¹ “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”² Because the Office Action provides no explanation of why Applicant’s claimed features are inherent, Applicant submits that the

¹ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

² *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

rejection is improper.³

With respect to the rejection of Claims 8 and 16 as unpatentable over Morikoshi and Kawaguchi, Applicant respectfully submits that the amendment to Claims 8 and 16 overcome the outstanding ground of rejection. Amended Claims 8 and 16 recite, *inter alia*, "the stopper has a Young's modulus in a range of 2 megapascals to 10 megapascals."

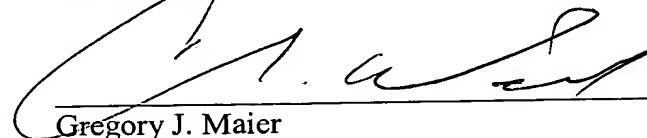
Neither Morikoshi nor Kawaguchi describe the above noted-element of amended Claims 8 and 16.

Thus, Applicant respectfully submits that amended Claims 8 and 16 patentably distinguish over Morikoshi and Kawaguchi, taken alone or in proper combination.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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³ MPEP § 2112, IV "Examiner must provide rationale or evidence tending to show inherency."